UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,698	06/30/2003	Hemingway Huynh	111255-135502	4440

			EXAMINER
25943	7590	11/28/2006	WON, MICHAEL YOUNG

SCHWABE, WILLIAMSON & WYATT, P.C.
PACWEST CENTER, SUITE 1900
1211 SW FIFTH AVENUE
PORTLAND, OR 97204

ART UNIT	PAPER NUMBER
2155	

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/611,698	HUYNH ET AL.
	Examiner	Art Unit	
	Michael Y. Won	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>22 September 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10,34 and 40-43* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10,34 and 40-43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is in response to the Request for Continued Examination and

amendment filed September 22, 2006.

2.   Claims 1, 3-10, and 34 have been amended and new claims 40-43 have been

added.

3.   Claims 1-10, 34, and 40-43 have been examined and are pending with this

action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter, which the applicant regards as his invention.

4.   Claims 1, 6, and 34 is rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. The examiner cannot determine the functional

limitation of "first reference is given effect". Although the specification states "inclusion

link 212 is **given effect** in order to incorporate the testing and selecting" (see page 8,

lines 4-6: emphasis added), there is no other recitation or example of what functionality

this **given effect** encompasses.

5.   Claims 1, 6, and 34 recite the limitation "**first** reference" (emphasis added).

There is insufficient **numerical** antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 1-10, 23, 34, 40, and 41 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Sahai et al. (US 6,594,699 B1) in view of Parolkar et al. (US 6,704,

396 B2).

INDEPENDENT:

As per **claim 1**, Sahai teaches an article comprising:

a storage medium (see col.8, line 37: "stored on the server"); and

instructions stored in the storage medium, which, when executed by a processor

(see col.2, line 47: "server computer/processor 10" and col.8, lines 48-50: "computer

program executing on said server"), cause the processor to generate and transmit one

or more messages to a receiving computer system (see col.2, lines 61-64: "responds to

the transfer request by streaming the data over the network to the client"), the one or

more messages including:

logic for testing digital content capabilities of the receiving computer system (see col.3, lines 15-19: "check whether client that has accessed the server has a client capabilities files stored" and col.5, lines 7-14: "capabilities... are then determined"); and

logic for displaying a selected one of a plurality of versions of digital content selected based on the results of testing digital content capabilities of the receiving computer system (see col.4, lines 41-43: "Chooses the appropriate software and hardware decoders to be used for playback of multimedia streams based on the client machine capabilities"), such that the receiving computer system may use the media message to display the selected version of the digital content (see col.5, lines 45-46: "media player plays 38 the data as it is received to the user of the client 12").

Although Sahai teaches of a media message (see col.2, lines 59-60: "multimedia data") and logic for testing the digital content capabilities of the receiving computer system (see above), Sahai does not explicitly teach of including a first reference and testing when the first reference is given effect.

Parolkar teaches of a first reference and testing when the first reference is given effect (see col.12, lines 43-55: "send a SIP message with the interactive script to determine the capability of the user's smart device").

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Sahai in view of Parolkar to implement a first reference and testing when the first reference is given effect. One would be motivated to do so because Sahai teaches that alternatively a server can send or

stream an application to the client to retrieve the capabilities of the client (see col.6, lines 57-63).

As per *claim 6*, Sahai teaches a method in a computing system for presenting an adaptive message (see col.5, lines 41-45: "formatting the data and adapting it"), comprising:

receiving a message in the computing system (see col.5, lines 41-45: "steams 36 the data to the of the client 12");

based on the contents of the received message: testing, two or more digital content capabilities (see col.3, lines 25-60) of the computing system (see col.3, lines 15-19: "check whether client that has accessed the server has a client capabilities files stored" and col.5, lines 7-14: "capabilities… are then determined"); selecting one of a plurality of different digital content elements based upon the results of the testing (see col.4, lines 41-43: "Chooses the appropriate software and hardware decoders to be used for playback of multimedia streams based on the client machine capabilities"); and presenting the selected one of the plurality of different digital content elements within the message (see col.5, lines 45-46: "media player plays 38 the data as it is received to the user of the client 12").

Sahai does not explicitly teach of message including a first reference and testing when the first reference is given effect.

Parolkar teaches of a first reference and testing when the first reference is given effect (see col.12, lines 43-55: "send a SIP message with the interactive script to determine the capability of the user's smart device").

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Sahai in view of Parolkar to implement a first reference and testing when the first reference is given effect. One would be motivated to do so because Sahai teaches that alternatively a server can send or stream an application to the client to retrieve the capabilities of the client (see col.6, lines 57-63).

As per *claim 34*, Sahai teaches an article comprising:

a storage medium (see col.8, line 37: "stored on the server"); and

instructions stored in the storage medium, which, when executed by a processor (see col.2, line 47: "server computer/processor 10" and col.8, lines 48-50: "computer program executing on said server"), cause the processor to generate and transmit one or more messages to a receiving computer system (see col.2, lines 61-64: "responds to the transfer request by streaming the data over the network to the client"), the one or more messages including:

logic for testing capabilities of the receiving computer system (see col.3, lines 15-19: "check whether client that has accessed the server has a client capabilities files stored" and col.5, lines 7-14: "capabilities... are then determined"); and

logic for displaying a selected one of a plurality of versions of media content selected based on the results of testing capabilities of the receiving computer system (see col.4, lines 41-43: "Chooses the appropriate software and hardware decoders to be used for playback of multimedia streams based on the client machine capabilities"), such that the receiving computer system may use the media message to display the

selected one of the plurality of versions of the media content (see col.5, lines 45-46:

"media player plays 38 the data as it is received to the user of the client 12").

Although Sahai teaches of a media message (see col.2, lines 59-60: "multimedia

data") and logic for testing the digital content capabilities of the receiving computer

system (see above), Sahai does not explicitly teach of including a first reference and

testing when the first reference is given effect.

Parolkar teaches of a first reference and testing when the first reference is given

effect (see col.12, lines 43-55: "send a SIP message with the interactive script to

determine the capability of the user's smart device").

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to modify the system of Sahai in view of Parolkar to implement a

first reference and testing when the first reference is given effect. One would be

motivated to do so because Sahai teaches that alternatively a server can send or

stream an application to the client to retrieve the capabilities of the client (see col.6,

lines 57-63).

DEPENDENT:

As per **claim 2**, which depends on claim 1, Sahai further teaches wherein the

instructions, when executed by the processor, generate the one or more messages

such that the logic is directly contained in the one or more messages (see col.6, lines

60-63).

As per *claim 3*, which depends on claim 1, Sahai further teaches wherein the

instructions, when executed by the processor, generate the one or more messages

such that the logic is included in the one or more messages by reference (see col.8,

lines 45-47).

As per *claim 4*, which depends on claim 1, Sahai further teaches wherein the

instructions, when executed by the processor, generate the one or more messages

such that the selected one of the plurality of versions of the digital content is not directly

included in the media message as first transmitted to the receiving computer system,

but is separately transferred under the control of the logic for displaying (see col.3, lines

15-19).

As per *claim 5*, which depends on claim 1, Sahai further teaches wherein the

instructions, when executed by the processor, generate the one or more messages

such that the selected one of the plurality of versions of the digital content is

downloaded by the logic for displaying, and is downloaded in a form customized for an

addressee of the message (see col.5, lines 41-46).

As per *claim 7*, which depends on claim 6, Sahai further teaches wherein the

plurality of different digital content elements includes a high-quality video sequence and

a low-quality video sequence (see col.4, lines 25-27).

As per *claim 8*, which depends on claim 6, Sahai further teaches wherein the

plurality of different digital content elements includes a video sequence and an

animation sequence (implicit: see col.3, lines 57-60 and col.4, lines 25-27).

As per *claim 9*, which depends on claim 6, Sahai further teaches wherein the plurality of different digital content elements includes a first digital content element constructed for playing on a first player and a second digital content element constructed for playing on a second player different from the first player (implicit: see col.3, lines 34-40).

As per *claim 10*, which depends on claim 6, Sahai further teaches wherein the selected one of the different digital content elements is selected based upon actions of a user of the computer system in connection with the received message (see col.2, lines 16-18 and col.3, lines 46-49).

As per *claim 40*, which depend on claim 1, Sahai further teaches wherein the instructions, when executed by the processor, generate the one or more messages such that the logic for testing digital content capabilities of the receiving computer system includes a script to be executed by the receiving computer system to test said digital content capabilities (see col.5, lines 26-31).

As per *claim 41*, which depend on claim 34, Although Sahai further teaches wherein the instructions, when executed by the processor, generate the one or more messages such that the logic for displaying are appended to the media message (see col.3, lines 15-22), Sahai does not explicitly teach that the logic for testing is also appended.

Parolkar teaches wherein the logic for testing is appended (see col.12, lines 43-55: "send a SIP message with the interactive script to determine the capability of the user's smart device").

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to modify the system of Sahai in view of Parolkar so that the logic

for testing is appended. One would be motivated to do so because Sahai teaches that

alternatively a server can send or stream an application to the client to retrieve the

capabilities of the client (see col.6, lines 57-63).

7.   Claims 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Sahai et al. (US 6,594,699 B1) and Parolkar et al. (US 6,704, 396 B2) and further

in view of Li et al. (US 6,345,279 B1).

As per *claim 42*, which depend on claim 34, Sahai and Parolkar do not explicitly

teach wherein the instructions, when executed by the processor, generate the one or

more messages such that the media message further includes: a replaceable section to

be replaced by a replacing section including the selected one of the plurality of versions

of media content.

Li teaches of a replaceable section to be replaced by a replacing section

including the selected one of the plurality of versions of media content (see col.5, lines

55-62).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to modify the system of Sahai and Parolkar in view of Li by

implementing a replaceable section to be replaced by a replacing section including the

selected one of the plurality of versions of media content. One would be motivated to

do so because Sahai teaches that the invention is useful in any client server interactions

(see col.7, lines 22-23).

As per *claim 43*, which depend on claim 42, Sahai further teaches wherein the

instructions, when executed by the processor, generate the one or more messages

such that the logic for displaying includes a replace script (see col.5, lines 26-31) to

replace the replaceable section of the media message with the replacing section (see

claim 42 rejection above).

Response to Arguments

8.   Applicant's arguments with respect to independent claims have been considered

but are moot in view of the new ground(s) of rejection. In view of the amended claim

language and responsive to further searching and consideration, claims 1, 6, and 34 are

rejected under 35 U.S.C. 103(a) as being unpatentable over Sahai et al. (US 6,594,699

B1) in view of Parolkar et al. (US 6,704, 396 B2). Sahai teaches all the limitations of

claims 1, 6, and 34 except "including a first reference" and "testing when the first

reference is given effect". Parolkar teaches the missing deficiencies of Sahai.
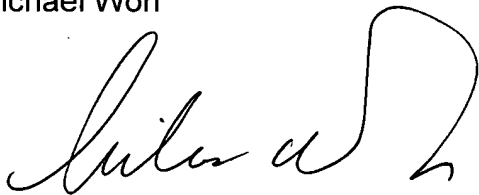
Conclusion

9.   For the reasons above claims 1-10, 34, and 40-43 are rejected and remain

pending.

10.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Michael Y. Won whose telephone number is 571-272-

3993. The examiner can normally be reached on M-Th: 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael Won

November 20, 2006